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01-719

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Taravade, Defibaugh  
Serial Number: 10/039,508  
Filed: 2001.11.09  
Title: Adjustable Transmission Phase Shift Mask  
Examiner: Nicole M. Barreca  
Group Art Unit: 1756  
Attorney Docket: 01-719

OFFICIAL

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Non-Fee Amendment  
Commissioner for Patents  
P.O Box 1450  
Alexandria VA 22313-1450

Via Fax at 1.703.872.9310

Sir:

In response to the restriction requirement dated 2003.08.08, please amend the above-referenced application as given herein.


The following items are included with this communication:

- ☒ [X] Response to Office Action (7 sheets, including this cover page).
- ☐ [ ] Proposed Drawing Changes (# sheets).
- ☐ [ ] Replacement Specification (# sheets).
- ☐ [ ] Petition for Extension of Time (1 sheet).

\* \* \*

I hereby certify that this correspondence is being transmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6(d) on the date below.

2003.09.04  
Date

  
Rick Barnes, 39,596

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### RESTRICTION REQUIREMENT

Claims 1-20 are in the case and subject to a restriction requirement. Applicants hereby elect with traverse to prosecute the claims of Group I, including claims 1-6. Thus, claims 7-20 are withdrawn from consideration. Reconsideration is requested.

Restriction is not required by 35 U.S.C. § 121. Congress wisely granted the *discretion* to restrict applications. According to 35 U.S.C. § 121 "... the Commissioner *may* require the application to be restricted..." (emphasis added). Likewise, MPEP § 803 lists two criteria that must be present for restriction to be proper:

1. The invention must be independent or distinct; and
2. There must be a serious burden on the examiner if restriction is not required.

In searching the Group I claims, the class and subclass for the Group II-IV claims will undoubtedly be searched, to ensure that no relevant art is overlooked. For this reason there is no significant burden on the examiner, and certainly no serious burden as required by MPEP § 803. In fact, maintaining the requirement for restriction not only burdens applicants with the additional costs associated with filing and prosecuting separate patent applications, but also requires the examiner to duplicate efforts by examining multiple applications of closely related inventions. Such practice not only wastes public and private funds and Patent Office resources, but also leads to the possibility of inconsistent examinations of closely related inventions. Accordingly, applicants respectfully request that the examiner reconsider and withdraw the restriction requirement.

In light of the foregoing, applicants respectfully submit that a full and complete response to the office action is provided herein, and request that the application proceed to examination.


In the event this response is not timely filed, applicants hereby petition for the appropriate extension of time and request that the fee for the extension be charged to deposit account 12-2355. If other fees are required by this amendment, such as fees for additional claims, such fees may be charged to deposit account 12-2252. Should the

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examiner require further clarification of the invention, it is requested that she contact the undersigned before issuing the next office action.

Sincerely,

LUEDEKA, NEELY & GRAHAM, P.C.

By: 

Rick Barnes, 39,596

2003.09.04

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